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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/072,599	02/05/2002	Robert H. Dahl	CB-11	2789
21394	7590	12/15/2004	EXAMINER	
ARTROCARE CORPORATION 680 VAQUEROS AVENUE SUNNYVALE, CA 94085-3523			HAYES, MICHAEL J	
			ART UNIT	PAPER NUMBER
			3763	

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/072,599	DAHLA ET AL.
	Examiner	Art Unit
	Michael J. Hayes	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 22 October 2004.  
 2a) This action is FINAL. 2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-82 is/are pending in the application.  
 4a) Of the above claim(s) 13, 15-22, 28-36 and 38-82 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-12, 14, 23-27 and 37 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 05 February 2002 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1)  Notice of References Cited (PTO-892)  
 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 8/04/04, 8/06/04.

4)  Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5)  Notice of Informal Patent Application (PTO-152)  
 6)  Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of group I and species 10 drawn to fig. 16B in the reply filed on 10/22/04 is acknowledged.

Claims 13, 15-22, 28-36, and 38-82 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/22/04.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 24 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 24 (dependent upon claim 23) is indefinite in reciting that the spacer encircles the active electrode distal head and is also located proximal to the active electrode head (claim 23). These two conditions are mutually exclusive.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 3, 6, 7, 8, 10, 11, 12, 23, 24, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by RYAN (US Patent No. 6,280,441). Ryan discloses an electrosurgical probe including a return electrode coil with gaps, and active electrode within a void of the return coil, and a connection block for coupling the probe to a power supply (6:50-58). The return electrode coil has about 6 turns, is parallel to the longitudinal axis of return electrode filament, the wire distal terminus is part of (i.e., within) the coil, the first turn is at the distal end (whether the first turn is considered at the distal or proximal end is merely a matter of whether counting starts at the distal or proximal end), and an insulating spacer proximal to the electrode head (See figs. 3, 5; col:lines 3:26-40, 6:31-58)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 9, 14, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYAN in view of GOBLE (US Patent No. 5,891,134). Ryan discloses the claimed invention as discussed above except for the helix pitch of 0.01-0.045in., electrode coil external diameter 0.07-0.2 in., return electrode filament diameter 0.008-0.03 in., active electrode filament diameter 0.006-0.02 in., ceramic insulating spacer, and handle housing the connection block.

Goble teaches the use of a ceramic insulating spacer and handle housing the connection block. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Goble in the probe of Ryan in order to use a well-known material for insulation and to obtain an efficient device that is easy to use by having the handle house the connection. With respect to claims 4, 5, 9, 14 it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the probe disclosed by Ryan to the claimed dimensions because Applicant has not stated that these dimensions are for a stated purpose or to solve a particular problem and it appears other dimensions would work equally as well. Applicant has not supplied any criticality with respect to these dimensions and they are merely design choice.

Claims 24 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over RYAN in view of COHEN (US Patent No. 4,832,048). Ryan discloses the claimed invention except for making the insulating member of alumina and the electrodes of titanium. Cohen teaches to use these materials for insulation and for the electrodes. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the teachings of Cohen in the probe of Ryan in order to make an electrosurgical probe using common, well-known materials for insulation and electrodes.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Hayes at (703) 305-5873. The examiner can usually be reached Monday -Thursday, 7:00-4:30, and on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi, can be contacted at (703) 308-2698. The fax number for submitting official papers is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mjh  
10 December 2004



MICHAEL J. HAYES  
PRIMARY EXAMINER